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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,475	05/15/2001	Naomi Go	206677US6	8087

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EXAMINER

LIN, KENNY S

ART UNIT PAPER NUMBER

2154

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,475

Applicant(s)

GO, NAOMI

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 7-10 and 18-20 are presented for examination. Claims 1-6 and 11-17 were previously withdrawn.

Election/Restrictions

2. Newly submitted claims 18-20 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 18-20 have separate utility such as registering the received information corresponding to the destination and personal preferences with the information providing apparatus and requires different class search and further reconsideration.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Akester et al (hereinafter Akester), WO 97/37499, published on October 9, 1997.
5. Akester was cited in the previous office action.
6. As per claim 10, Akester taught the invention as claimed including a program-storing medium for storing a computer-executable program, comprising:
 - a. An input control step of controlling an operation to input transmitted information on a first transmission destination (e.g., voice message service), a second transmission destination (e.g., office telephone number) and a criterion for selecting either said first transmission destination or said second transmission destination from an information-presenting apparatus (page 1, lines 19-33, page 7, lines 12-19, page 21, lines 7-10, 29; priorities or confidence value CV); and
 - b. A transmission control step of controlling transmission of information on said first transmission destination, said second transmission destination and a criterion

for selecting either said first transmission destination or said second transmission destination to said information-presenting apparatus (page 6, lines 9-21, page 7, lines 1-11, page 21, lines 20-22).

7. Claim 10 is further rejected under 35 U.S.C. 102(e) as being anticipated by O'Neal, US 6,711,154.

8. O'Neal was cited in the previous office action.

9. As per claim 10, O'Neal taught the invention as claimed including a program-storing medium for storing a computer-executable program, comprising:

- a. An input control step of controlling an operation to input transmitted information (col.8, lines 37-67) on a first transmission destination (e.g., voice information delivered to telephone), a second transmission destination (e.g., text delivered to email) and a criterion for selecting either said first transmission destination or said second transmission destination from an information-presenting apparatus (col.8, lines 37-67, col.9, lines 16-20, 28-31, 33-67, col.10, lines 1-32, col.11, lines 2-12, 14-45, col.12, lines 45-46, 51-61); and
- b. A transmission control step of controlling transmission of information on said first transmission destination, said second transmission destination and a criterion for selecting either said first transmission destination or said second transmission

destination to said information-presenting apparatus (col.7, lines 59-67, col.8, lines 1-7, col.11, lines 2-12, 14-45).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neal, US 6,711,154, in view of Mayer, US 5,774,534.

12. As per claims 7 and 9, O'Neal taught the invention substantially as claimed including an information-processing apparatus, method and a program-storing medium for storing a computer-executable program, comprising:

- a. An interface configured to control an operation to input transmitted information (col.8, lines 37-67) on a first transmission destination (e.g., voice information delivered to telephone), a second transmission destination (e.g., text delivered to email) and a criterion for selecting either said first transmission destination or said second transmission destination from an information-presenting apparatus (col.8, lines 37-67, col.9, lines 16-20, 28-31, 33-67, col.10, lines 1-32, col.11, lines 2-12, 14-45, col.12, lines 45-46, 51-61); and

- b. A transmission controller configured to control transmission of information on said first transmission destination, said second transmission destination and a criterion for selecting either said first transmission destination or said second transmission destination to said information-presenting apparatus (col.7, lines 59-67, col.8, lines 1-7, col.11, lines 2-12, 14-45), wherein said information-presenting apparatus is configured to store commodity information corresponding to a geographic location.

13. O'Neal did not specifically teach that the information-presenting apparatus is configured to store commodity information corresponding to a geographic location. Mayer taught to store commodity information corresponding to a geographic location in a database of an information-presenting apparatus (col.17, lines 6-9, col.19, lines 63-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of O'Neal and Mayer because Mayer's teaching of storing commodity information enables O'Neal's information-presenting apparatus to present information such as sales advertisements to the transmission destinations.

14. As per claim 8, O'Neal and Mayer taught the invention substantially as claimed in claim 7. O'Neal further taught said interface further controls an operation to input transmission-method information indicating a first transmission method for said first transmission destination and a second transmission method for said second transmission destination, whereas said transmission control means is capable of controlling transmission of information on transmission

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methods to said information-presenting apparatus (col.8, lines 37-67, col.9, lines 16-20, 28-31, 33-67, col.10, lines 1-32, col.11, lines 2-12, 14-45, col.12, lines 45-46, 51-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of O'Neal and Mayer because Mayer's teaching of storing commodity information enables O'Neal's information-presenting apparatus to present information such as sales advertisements to the transmission destinations.

Response to Arguments

15. Applicant's arguments with respect to claims 7-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stewart, US 5,835,061.

Power, US 6,285,991.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
May 16, 2005


JOHN FOLLANSBEE
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